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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,387	06/05/2000	Yukihiro Matsumoto	2000 0669A	7551

7590 08/27/2003
Wenderoth Lind & Ponack LLP
2033 K Street NW
Suite 800
Washington, DC 20006

[REDACTED] EXAMINER

MANOHARAN, VIRGINIA

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1764

DATE MAILED: 08/27/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/587,387	MATSUMOTO ET AL.	
	Examiner	Art Unit	
	Virginia Manoharan	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 May 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 11-28 is/are pending in the application.
- 4a) Of the above claim(s) 11-18 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 19-21,23-25,27 and 28 is/are rejected.
- 7) Claim(s) 22 and 26 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-21 and 23 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hego et al and Nezu et al.

The above references are applied for the same combined reasons as set forth at pages 4-5 of the previous Office action.

Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Popov or JP '030.

Claims 22 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed May 13, 2003 have been fully considered but they are not persuasive.

Applicants following arguments such as:

In Hego, "...Although the polymerization inhibitor is added in the recycled liquid stream, the section where the polymerization would be inhibited is a cooling column 1 in the purification section.... Thus, the present invention is unobviously different from Hego et al who merely inhibit the polymerization in the purification section....

Further, Hego et al treats the gaseous mixture, which flows into the cooling column 1 directly from unit 30 of the gas-phase oxidation of propylene. On the other hand, the present invention treats a gas containing an easily polymerizable compound from a purifying section. . . Therefore, the present invention is absolutely different from Hego et al in regard to the section where the gas containing the polymerizable compound originates from..." are not persuasive of patentability for the following reasons:

- a. However, the argued "cooling column in the purification section" would at least be suggestive of the claimed vacuum section and gas liquid contact chamber. Compare with the instant claims 22-23 condensers which obviously fall within the cooling column of the prior art.

Furthermore, "where the gas containing the polymerizable compound originates from..." is of no patentable moment. The same result is achieved. That is, the active, manipulative, process wherein a gas containing an easily polymerizable compound is permitted to flow into a gas and liquid contact chamber and contact a polymerizable inhibitor as broadly claimed is known in the art. Applicants fail to delineate method steps not shown nor rendered obvious by the prior art. The fluid-in- process (product or material) and its source are not the basis of patentability of a process claim .

Moreover, the further arguments that "...it is not apparent how the vacuum pump disclosed in Nezu et al is applied to the purifying system in Hego et al, for example, where the vacuum pump should be placed. . . Thus, even if Nezu et al is combined with Hego et al, the present invention that focuses on inhibiting the polymerization in the

vacuum section is not disclosed..." are not considered well-taken. The argued "inhibiting the polymerization in the vacuum section is of no patentable significance as it is recited only in the preamble of claim 1. The preamble may or may not even be given a patentable weight.

With regards to where the vacuum pump of Nezu is to be placed in Hego's purifying system, as argued, it is well-recognized by now, that to support a rejection under 35 USC 103 based upon a combination of references it is not necessary that the features of one reference be capable of bodily insertion into another reference. Hego suggests the incorporation of a condenser in its system, which naturally or inherently produces vacuum in a distiller.

While Hego's cooling column operates at elevated pressure, as further argued, however, Hego likewise suggests at column 4, lines 14-16 that "one skilled in the art will be able to determine the appropriate pressure to use to avoid impairment...efficiency".

Thus, in the absence of anything, which may be "new" or "unexpected result", a *prima facie* case of obviousness has been reasonably established by the art and has not been rebutted.

Unexpected results must be established by factual evidence. Mere arguments or conclusory statements in the specification, applicants' amendments, or the Brief do not suffice. In re Linder, 457 F.2d 506, 508, 173, USPQ 356, 358 (CCPA 1972). In re Wood, 582, F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

This application contains claims 11-18 drawn to an invention nonelected with traverse in Paper No. 4. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to V. Manoharan whose telephone number is (703) 308-3844. The examiner can normally be reached on Tuesday--Friday from 7:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Calderola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9311 for regular communications and (703) 308-0651 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

V. Manoharan/dh
August 25, 2003


VIRGINIA MANOHARAN
PRIMARY EXAMINER
ART UNIT 1327
